



UNITED STATES PATENT AND TRADEMARK OFFICE

50
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,464	05/15/2001	Evangelos Trifon Laskaris	839-1063	8068

7590 09/10/2002

NIXON & VANDERHYE P.C.
1100 North Glebe Road, 8th Floor
Arlington, VA 22201

EXAMINER

CIRIC, LJILJANA V

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action SummaryApplication No.
09/854,464Applicant(s)
Laskaris et al.Examiner
Ljiljana V. CiricArt Unit
3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 15, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 3743

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 through 8, drawn to an apparatus for manufacturing high temperature superconducting coils, classified in class 505, subclass 150+.
 - II. Claims 9 through 17, drawn to a method of manufacturing high temperature superconducting coils, classified in class 29, subclass 605.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus that is Invention I as claimed can be practiced by a process which, unlike the process that is Invention II, comprises applying to each layer of the high temperature superconducting tape a binder which cures at room temperature and which therefore does not require baking. Alternately, the process that is Invention II as claimed can be practiced by an apparatus which, unlike the apparatus that is Invention I, includes an oven.

3. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I and vice versa, and also because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different

Art Unit: 3743

classification, restriction for examination purposes as indicated is proper. restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed inventions: the first species or the embodiment characterized by the plurality of blocks being assembled on the outer edge of the side plates via bolts with the bolts sized to stepwise compress the layers of the high temperature superconducting tape; the second species or the embodiment characterized by the plurality of blocks including blocks of different thicknesses for selective compressing according to the number of layers of the high temperature superconducting tape; the third species or the embodiment characterized by the plurality of blocks including a plurality of final blocks that are shaped according to the desired outside dimensions of the superconducting coils; the fourth species or the embodiment characterized by each of the winding step, the binder application step, and the compression step being practiced for each layer of the high temperature superconducting tape; the fifth species or the embodiment characterized by each of the binder application step and the compression step being practiced after winding multiple layers of the high temperature superconducting tape; the sixth species or the embodiment characterized by the binder application step being practiced by epoxy-impregnating the multiple wound layers of the high temperature superconducting tape by a vacuum pressure impregnation process; the seventh species or the embodiment characterized by the winding step being practiced using pre-preg coated high temperature superconducting tape; the eighth species or the embodiment characterized by the additional steps of securing a start lead of the coil to a lead terminal and of applying a binder layer to the bobbin practiced prior to the winding step; and, the ninth species or the embodiment

Art Unit: 3743

characterized by the additional steps of securing a finish lead of the coil to a lead terminal and of applying a layer of copper foil to the coil, coupled with an additional compression step under heat.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, while some claims are generic to several species, no single claim is generic to all of the species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 3743


6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925. While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett, can be reached on (703) 308-0101. The fax phone number is (703) 305-3463.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc


LJILJANA CIRIC
PATENT EXAMINER

September 5, 2002